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EXAMINER

KOLLIAS, ALEXANDER C

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

1. Applicants' amendment filed on 11/15/2010 has been fully considered; however, the amendment has not been entered given raises new issues that would require further consideration and/or search.
2. With respect to other new issues, Applicants have cancelled the amino group recited in the Markush group recited in claim 1. Given Applicants have cancelled an unpatentable species and given that a claim in Markush format does not necessarily require a search for all recited species for a proper examination, Applicant's amendment raises new issues necessitating a new search and/or consideration. Furthermore, newly added claim 22 drawn to a ink composition presents a combination of limitations not present at the time of the preceding Office Action, thereby necessitating further consideration and/or search. It is for these reasons that the Amended filed on 11/15/2010 is has not been entered.
3. Regarding the 37 C.F.R. 1.132 Declaration filed on 11/15/2010, it is noted that the Declaration has not been entered for the reasons set forth above in Paragraph 2.
4. Were the Amendment entered, Applicants' arguments regarding the prior art rejection of claim 15 would be persuasive for the following reasons:
5. Applicants argue that while Molloy discloses the use of anhydride, the reference discloses the use of the anhydride in combination the dicarboxylic acids, and therefore

does not disclose or suggest the use of an acid anhydride itself can function as a dispersant. However, it is significant to note the open language of the present claims (c.f. the use of the phrase “comprising”), and thus the present claims no in any way limit or prohibit the use or inclusion of other ingredients, including the dicarboxylic acids disclosed by Molloy.

6. With respect to Applicants' arguments regarding unexpected results of ink composition comprising acid anhydride and viscosity after aging as compared to ink compositions which do not comprise such compound, are found to be persuasive for the following reasons:

7. The comparison of Ink 1 (Comparative) to Inventive Example 1-A, presented in Table 1 of the present Specification, is a proper side by side comparison, it is noted that the present claims recite that the use of 0.01 to 30 wt % acid anhydride, based on the amount of metallic pigment while Inventive Example 1-A comprises 18.3 wt %. Similarly, although Inventive Examples 2-A and 2-B, are proper side by side comparisons with comparative Ink 2, with Inks 2-A and 2-B comprising 37.5 wt % acid anhydride and 28 wt % acid anhydride, it is significant to noted that Ink 2-A has an acid anhydride content of 37.5 wt %, relative to the amount of metallic pigments which is outside the presently claimed range of 0.1 to 30 wt %.

8. Furthermore although inventive inks 1-A and 2-B have amounts of acid anhydride within the presently claimed range, it is noted that these inventive examples have

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amounts towards the upper bound of the presently claimed range. That, is these examples do to disclose amounts of acid anhydride over the entire claimed range of 0.01 to 30 wt %. As set forth in MPEP 716.02(d), whether unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support". In other words, the showing of unexpected results must be reviewed to see if the results occurred over the entire claimed range, *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Applicants have not provided data to show that the unexpected results do in fact occur over the entire claimed range of acid anhydride.

9. Finally, it is noted that the present claims encompass any acid anhydride moiety as a $-C(=O)O(=O)-$ group in the acid anhydride, while the Inventive inks 1-A and 2-B comprise EPICRON B-4400 and dodecylsuccinic anhydride. That, while the present claims encompass the anhydride species utilized in the inventive inks, the claims encompass other anhydride species not exemplified by the inventive examples. Thus, the examples are not commensurate in scope with the scope of the present claims.

11/19/2010

Alexander Kollias

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Examiner, Art Unit 1796

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Supervisory Patent Examiner, Art Unit 1725